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09/867,532	05/31/2001	Tomohiro Aiso	914-131	6763

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EXAMINER

MAURO JR, THOMAS J

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/867,532

Applicant(s)

AISO, TOMOHIRO

Examiner

Thomas J. Mauro Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-17,25-34,42-51 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ☐
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20010531, 20040624.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, 18-24, 35-41 and 52-53, drawn to transmitting information based on access conditions, classified in class 709, subclass 207.
  - II. Claims 8-17, 25-34, 42-51 and 54, drawn to insertion of advertisements into a conference/chat room or webpage, classified in class 709, subclass 204.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as an electronic conference systems providing notifications based on the access status of client computers (Specification Page 3 lines 24-28). In the instant case, invention II has separate utility such as an electronic conference system providing efficient advertising to clients (Specification Page 4 lines 15-20). See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Additionally, the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Joe Presta (Reg. # 35,329) on November 8, 2004 a provisional election was made without traverse to prosecute the invention of Group II, claims 8-17, 25-34, 42-51 and 54. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7, 18-24, 35-41 and 52-53 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. After election, claims 8-17, 25-34, 42-51 and 54 are pending and are presented for examination. A formal action on the merits of claims 8-17, 25-34, 42-51 and 54 follows.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 8, 11-12, 14, 25, 28-29, 31, 42, 45-46, 48 and 54 are rejected under 35

U.S.C. 102(e) as being anticipated by Ballard (U.S. 6,182,050).

With respect to claim 8, Ballard teaches a server operation support apparatus supporting an operation of a server to which a plurality of client computers are connected through a

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network, said server allowing insertion of an advertisement that can be viewed by said plurality of client computers **[Ballard -- Abstract]**, said server operation support apparatus comprising:

storage means for storing in advance information indicating an advertiser **[Ballard --**

**Col. 8 lines 44-56 – Advertisement information is stored electronically];**

detection means connected to said network for detecting an access status of a client computer to said server **[Ballard -- Col. 7 lines 14-31 and lines 50-65 – Affinity rankings are monitored as one criteria to determine which advertisements are to be displayed and when. Affinity rankings include an access status, i.e. user's only history/habits, namely what sites they have visited and how often, etc.];**

designation means connected to said storage means and said detection means for designating insertion of an advertisement to said server according to information indicating an advertiser stored in said storage means, when said access status detected by said detection means satisfies a predetermined condition **[Ballard -- Figure 3, Col. 10 lines 1-25 and Col. 11 lines 29-61 – Advertisements are selected for insertion when the access status, i.e. affinity ranking, satisfies a given ranking condition, i.e. some predetermined level].**

With respect to claim 11, Ballard further teaches the apparatus further comprising communication means for communicating with said advertiser to receive advertisement data from said advertiser, wherein said designation means comprises means for designating insertion of an advertisement realized by said received advertisement data to said server **[Ballard -- Col. 8 lines 44-56 – Advertisers submit advertisement data to Advertising Service Provider (ASP) along with target criteria for when to insert the data].**

With respect to claim 12, Ballard further teaches wherein said designation means comprises means for transmitting insertion query information including insertion confirmation information confirming whether an advertisement is to be posted or not to the advertiser whose information is stored in said storage means, when said access status detected by said detection means satisfies a predetermined condition, and means for suppressing an operation by said designation means in response to not receiving an insertion request corresponding to said insertion query information within a predetermined period [**Ballard -- Col. 8 lines 7-21 and Col. 10 lines 26-41 -- Report information is transmitted to ASP and then to advertisers to provide them with information concerning their advertisements and the current campaign, such as the dates and times of display for a particular ad, etc.].**

With respect to claim 14, Ballard further teaches wherein said means for transmitting insertion query information comprises means for transmitting said insertion query information a plurality of advertisers [**Ballard -- Col. 8 lines 7-21 and Col. 10 lines 26-41 -- Report information is transmitted to ASP and then to advertisers to provide them with information concerning their advertisements and the current campaign, such as the dates and times of display for a particular ad, etc.], wherein said predetermined condition includes a condition determined for each said advertiser [Ballard -- Col. 7 lines 14-31 and Col. 10 lines 58-67 -- Predetermined conditions can consist of multiple conditions, such as affinity ranking, number of users during a time period, time slot, number of end users to receive advertisement, etc.].**

With respect to claims 25, 28-29 and 31, these are apparatus circuit claims similar to the apparatus claimed in claims 8, 11-12 and 14 above. They have similar limitations; therefore, claims 25, 28-29 and 31 are rejected under the same rationale.

With respect to claims 42, 45-46 and 48, these are method claims similar to the apparatus claimed in claims 8, 11-12 and 14 above. They have similar limitations; therefore, claims 42, 45-46 and 48 are rejected under the same rationale.

With respect to claim 54, Ballard teaches a computer-readable recording medium recorded with a program [**Ballard -- Col. 5 lines 65-67 -- Col. 6 lines 1-23**]. The remaining limitations in claim 54 are similar to the limitations claimed in claim 8. Therefore, they are rejected under the same rationale.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 9, 26 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050).

Regarding claim 9, Ballard teaches the invention substantially as claimed, including wherein said predetermined condition includes a condition that a value calculated is at least a predetermined value [**Ballard -- Col. 11 lines 39-43 – Affinity ranking, which contains access status such as online history/habits, selects ads based upon whether the ranking is above a prescribed or programmable threshold level**].

Although not explicitly taught, it would have been obvious to a person of ordinary skill in the art that keeping track of a user's online viewing and access habits/history would include the number of access to a given site/server in order to track the user's habits. It would have been obvious to include this tracking statistic in order to provide better advertising results to both advertisers and users, such that advertisers would be targeting clients which have an interest in some subject/site because they access the site frequently, and users would receive advertisements which are more likely to interest them rather than random advertisements.

Regarding claim 26, this is an apparatus circuit claim similar to the apparatus claimed in claim 9 above. It has similar limitations; therefore, claim 26 is rejected under the same rationale.

Regarding claim 43, this is a method claim similar to the apparatus claimed in claim 9 above. It has similar limitations; therefore, claim 43 is rejected under the same rationale.



10. Claims 10, 15-16, 27, 32-33, 44 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050) in view of Gupta et al. (U.S. 6,487,538).

Regarding claim 10, Ballard teaches the invention substantially as claimed, as aforementioned in claim 8 above, but fails to explicitly teach wherein the advertising fee is set according to the access status.

Gupta, however, discloses an advertising system which advertisers pay an advertisement fee based on the number of times different users access a given site and see the add, i.e. a site hit **[Gupta -- Col. 4 lines 26-36 and Col. 5 lines 66-67 – Col. 6 lines 1-9]**.

Both Ballard and Gupta are concerned with providing targeted advertisements to users over the Internet.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the advertising fee based upon number of accesses to a given site/server, as taught by Gupta into the invention of Ballard, in order to provide a fair and cost effective solution to advertisers by charging fees dependent upon how many viewers actually view a site thereby allowing advertisers to more effectively place advertisements pay fees commensurate with what the campaign was actually worth.

Regarding claim 15, Ballard teaches the invention substantially as claimed, as aforementioned in claim 14 above, but fails to explicitly teach wherein the advertising fee is set according to the access status for each advertiser.

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Gupta, however, discloses an advertising system which advertisers pay an advertisement fee based on the number of times different users access a given site and see the add, i.e. a site hit **[Gupta -- Col. 4 lines 26-36 and Col. 5 lines 66-67 – Col. 6 lines 1-9]**. It would have been obvious to a person of ordinary skill in the art that this fee would differ based upon the advertiser's advertisement, i.e. size, campaign outreach, etc., thereby providing customized ad prices to users which require varying levels of advertising.

Both Ballard and Gupta are concerned with providing targeted advertisements to users over the Internet.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the advertising fee based upon number of accesses to a given site/server for each advertiser, as taught by Gupta into the invention of Ballard, in order to provide a fair and cost effective solution to advertisers by charging fees dependent upon how many viewers actually view a site thereby allowing advertisers to more effectively place advertisements pay fees commensurate with what the campaign was actually worth.

Regarding claim 16, Ballard-Gupta teach the invention substantially as claimed, as aforementioned in claim 15 above, including wherein said designation means comprises means for designating insertion of said advertisement to said server in a descending order of said advertising fee **[Gupta -- Col. 12 lines 8-50 – Most expensive ads are shown first and then rotated with other ads which would obviously be less expensive, thereby having a descending order]**.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate displaying ads in a descending order of ad fee in order to allow the advertisers to find an optimum balance for maximizing revenue brought in from advertisements and minimizing the cost of advertisements, thus found by placing ads in a descending order.

Regarding claims 27 and 32-33, these are apparatus circuit claims corresponding to the apparatus claimed in claims 10 and 15-16 above. They have similar limitations; therefore, claims 27 and 32-33 are rejected under the same rationale.

Regarding claims 44 and 49-50, these are method claims corresponding to the apparatus claimed in claims 10 and 15-16 above. They have similar limitations; therefore, claims 44 and 49-50 are rejected under the same rationale.

11. Claims 13, 30 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050) in view of Matsumoto et al. (U.S. 6,763,334).

Regarding claim 13, Ballard teaches the invention substantially as claimed, as aforementioned in claim 12 above, but fails to explicitly teach wherein said insertion query information includes access information indicating an access status.

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Matsumoto, however, discloses a system for arranging the delivery of advertisements over the Internet which includes generating a statistical report containing access information regarding a particular advertising campaign [**Matsumoto -- Figures 7-9, Col. 10 lines 31-67 – Col. 11 lines 1-67**].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the inclusion of access statistics into a report, as taught by Matsumoto into the invention of Ballard, in order to allow the advertiser to better evaluate the effectiveness of an ad campaign [**Matsumoto -- Col. 11 lines 16-19**].

Regarding claim 30, this is an apparatus circuit claim similar to the apparatus claimed in claim 13 above. It has similar limitations; therefore, claim 30 is rejected under the same rationale.

Regarding claim 47, this is a method claim similar to the apparatus claimed in claim 13 above. It has similar limitations; therefore, claim 47 is rejected under the same rationale.

12. Claims 17, 34 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050) and Gupta et al. (U.S. 6,487,538), as applied to claims 15, 32 and 49 above respectively, in view of Matsumoto et al. (U.S. 6,763,334).

Regarding claim 17, Ballard-Gupta teach the invention substantially as claimed, as aforementioned in claim 15 above, but fail to explicitly teach wherein said insertion information includes charge information indicating the advertising fee set.

Matsumoto, however, discloses an advertisement system which indicates the cost per response of the advertisement and the total projected sales which are expected from the campaign

**[Matsumoto -- Figure 4 and Col. 6 lines 22-39].**

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the charge information/fee of the advertisement, as taught by Matsumoto into the invention of Ballard-Gupta, in order to provide a user-friendly view of the information associated with an ad campaign which allows the advertiser/affiliate to determine the cost/revenue and other financial information about the campaign.

Regarding claim 34 this is an apparatus circuit claim similar to the apparatus claimed in claim 17 above. It has similar limitations; therefore, claim 34 is rejected under the same rationale.

Regarding claim 51, this is a method claim similar to the apparatus claimed in claim 17 above. It has similar limitations; therefore, claim 51 is rejected under the same rationale.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Blaser et al. (U.S. 6,757,661) discloses a system for targeting advertisements to users based upon different criteria including network usage information and interactive data.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 571-272-3917. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TJM  
November 10, 2004



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